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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/676,435

10/01/2003

Maria Hanna Joseph

18973-00001

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7590

06/04/2004

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EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/676,435

Applicant(s)

JOSEPH, MARIA HANNA

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Goodwin (4,203,240).

Goodwin discloses a method of providing permanent or removable indicia comprising information (25, 50) on the top (as seen in figure 5), bottom (as seen in figure 3) and/or side (as seen in figure 4) surfaces of lids (15) for containers (10) that hold substances intended for individual consumer consumption for purposes of serving as a medium for carrying promotional information (see col. 2, lines 28-29), the method comprising providing a lid (15) for a cup or container (10) that holds liquids, the lid defining top, side and bottom surfaces (as seen in figures 3-6); and placing indicia (25, 50) on at least one surface of the lid.

Regarding the purpose of serving as a medium for carrying advertising, promotion, decoration, imaging, printing instruction, and information, as well as features that make the lid, cover or closure more aesthetically attractive such as color and texture, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is

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capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, Goodwin is capable of performing the intended use as set forth above.

Regarding claim 2, Goodwin discloses the lid being made of any material conductive to and appropriate for containing hot or cold liquids, or other substances since the container is a beverage container which would, inherently, have some type of drinking substance, hot or cold, for consumption.

Regarding claim 3, Goodwin discloses placing the indicia onto the lid by any "suitable tamper proof means, such as imprinting or stamping" (see col. 3, lines 1-3).

Regarding claim 4, Goodwin discloses the indicia being of any size or dimension necessary to fit on any and all sizes and styles of lids (as seen in figures 1-3, 5 and 6).

Regarding claim 5, Goodwin discloses permanently displaying the indicia on the lid since the indicia may be imprinted or stamped on the lid as set forth above.

Regarding claim 6, Goodwin discloses the indicia being temporarily displayed on the lid by placing the indicia (50) on the tear-tab (55) wherein the tear-tab is to be removed from the container (see col. 3, lines 42-48).

Regarding claim 7, Goodwin discloses the indicia being placed directly on the lid (as seen in figures 1-3, 5 and 6).

Regarding claims 8 and 9, Goodwin discloses the indicia being placed indirectly on the lid by placing the indicia on the tear-tab (55) that is removably coupled to the lid of the container.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodwin in view of Comann (5,380,045).

Goodwin discloses the claimed invention except for the removable coupling being accomplished with a peel-off sticker.

Comann discloses a beverage container for providing identification information comprising a regular label (11) containing a removable label (14) (see figures 3 and 4). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Goodwin's invention to include a removable label, as taught by Comann, to enable the removable label to be subsequently placed on other surfaces.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodwin in view of Lundell (5,329,713).

Goodwin discloses the claimed invention except for the removable coupling being accomplished with a perforated, tear-off member.

Lundell discloses a container for providing information having a label (11) with a main portion (12) and a secondary portion (15); wherein the secondary portion can be easily lifted up and stripped off of the main portion along the perforation (16) (see figure 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Goodwin's invention to include a perforated, tear-off member, as taught by Lundell, to indicate that the label has been tampered or altered.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose containers having labels.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (7:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 27, 2004

Monica S. Carter
MONICA S. CARTER
PRIMARY EXAMINER